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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,828	08/20/2003	Lars LARSSON	07589.0122.PCUS00	1827
28694	7590	11/18/2003	EXAMINER	
HOWREY SIMON ARNOLD & WHITE LLP 1299 PENNSYLVANIA AVE., NW BOX 34 WASHINGTON, DC 20004			GUSHII, ROSS N	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/604,828	LARSSON ET AL.	
	Examiner	Art Unit	
	Ross N. Gushi	2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 6, the device including that the thread is deformed was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Based on the specification, it appears that a deformed thread would render the device inoperable. The limitation treated as meaning that the device includes a thread.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in —

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a);

Claims 1, 3, 4, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Gehring et al. ("Gehring").

Regarding claim 1, Gehring discloses grounding element 10 for (i.e. capable of) making possible an electrical connection between a structural element and an electrical terminal, said grounding element comprising a first portion 14; a second portion 12 provided with a thread, a central section (16) connecting the first portion to the second portion and the central section having a first contact surface 17 in a plane where the central section is connected to the second portion and the first portion having a thread and the central section having a portion with at least one projecting ridge 42

Per claim 3, the central section further comprises a disk-shaped portion, one side surface of which forms the first contact surface.

Per claim 4, an edge of a disk-shaped portion of the central section has at least two parallel surfaces.

Per claim 6, Gehring discloses a thread on the second portion.

Per claim 7, the first contact surface is provided with at least one projection extending therefrom (col. 3, lines 20-25).

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Gulistan.

Per claim 8, Gulistan discloses an elongate grounding element for (i.e. capable of) affecting and facilitating an electrically grounded connection, the elongate grounding

element comprising an elongate body having a longitudinal axis and at least an externally threaded portion 39, said threaded portion having an insertible portion configured for non-threaded engagement with a support member (40, 45) when said threaded portion is inserted through a provided aperture in the support member; and a means 38 for (i.e. capable of) enhancing electrically conductive contact between the elongate body and the support member, said enhancement means comprising elongate ridges 38 radially extending off of a central portion of the elongate body, said central portion being configured for non-twisting insertion into the provided aperture in the support member in a direction substantially parallel to the longitudinal axis of the elongate body, said elongate ridges forming an interference fit with the support member at a periphery of the provided aperture.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gulistan as discussed regarding claim 8 in view of DeLeo. Gulistan does not explain that the terminal may be used for grounding. DeLeo discusses using a double threaded stud 31 for grounding to a support structure 30. At the time of the invention, it would have been obvious to use the Gulistan device as a ground stud as discussed by DeLeo. The

suggestion or motivation for doing so would have been to attach a circuit to the grounded support structure as taught in DeLeo.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehring as discussed regarding claim 1 in view of Attwood. Gehring does not disclose that the central section further comprises a truncated cone having a tip end interconnected with the first portion. Attwood discloses a fastener including a section 12 (analogous to flange 16 in Gehring) which comprises a truncated cone having a tip end interconnected with a threaded portion. At the time of the invention, it would have been obvious to modify the Gehring flange to include a conical section with teeth as taught in Attwood. The suggestion or motivation for doing so would have been to better facilitate the transmission of stress between the fastener and the support structure as taught in Attwood.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehring as discussed regarding claim 4 in view of Grow. Gehring does not disclose that the disk-shaped portion is a mechanical element with an internally threaded hole, which is mounted on the grounding element. Grow discloses an stud 47 and a disk-shaped portion 36 which is a mechanical element with an internally threaded hole, which is mounted on the stud. At the time of the invention, it would have been obvious to attach the Gehring flange using a threaded bore as taught in Grow. The suggestion or motivation for doing so would have been to be able to adjust the location of the flange axially and adjust the relative lengths of the stud shanks, as taught in Grow and as is well known in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (703) 306-4508. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at (703) 308-2319. The phone number for the Group's facsimile is (703) 872-9306.

A handwritten signature in black ink, appearing to read "Ross Gushi". The signature is fluid and cursive, with the first name "Ross" written in a larger, more prominent script than the last name "Gushi".